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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/854,280	05/10/2001	Jian Chen	P1381R1C2	8242

9157 7590 06/04/2003

GENENTECH, INC.
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SOUTH SAN FRANCISCO, CA 94080

EXAMINER

JIANG, DONG

ART.UNIT PAPER NUMBER

1646

DATE MAILED: 06/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/854,280

Applicant(s)

CHEN ET AL.

Examiner

Dong Jiang

Art Unit

1646

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 61-72 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 61-72 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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DETAILED OFFICE ACTION

Applicant's amendment in paper No. 15, filed on 10 March 2003 is acknowledged and entered.

Currently, claims 61-72 are pending and under consideration.

Rejections Over Prior Art:

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless —

(e) the invention was described in—

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

Claims 61-63 and 68-72 remain rejected under 35 U.S.C. 102(e) as being anticipated by Ebner et al., US 2003/0003545, for the reasons set forth in the last Office Action, paper No. 14, mailed on 25 February 2003, at page 3.

Applicants argument, filed on 10 March 2003 (paper No. 15) has been fully considered, but is not deemed persuasive for reasons below.

At page 2 of the response, the applicant argues that the Ebner reference has a filing date of May 27, 1999, and applicants pending application claims priority to US application 09/311,832, filed on May 14, 1999, which predates the filing date of May 27, 1999 of the Ebner reference, and therefore, it neither anticipates nor makes obvious the present invention. This argument is not persuasive because even though the Ebner reference has a filing date of May 27, 1999, it claim priority to US provisional applications, 60/131,965, 60/099,805 and 60/087,340, all of which have an earlier filing date than that of 09/311,832. Therefore, the cited reference remains anticipating the present claims.

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Claims 61-72 are rejected under 35 U.S.C. 102(e) as being anticipated by Gorman et al., US 6,562,578 B1.

Gorman discloses a nucleic acid, SEQ ID NO:22, which comprises nucleotides 50-640 of SEQ ID NO:4 of the present invention with 100% sequence identity, and encodes a human polypeptide of SEQ ID NO:23 with 100% identity to SEQ ID NO:3 of the present invention (see appended computer printout of sequence search result). Therefore, the cited sequence anticipates claims 61-67 and 72 as being a nucleic acid comprising DNA encoding amino acids of SEQ ID NO:3, or comprising nucleotides 50-640 or 104-640 of SEQ ID NO:4. Additionally, Gorman teaches a vector containing said nucleic acid (column 33, lines 11-46), a host cell thereof including E.coli, yeasts, mammalian cells such as CHO (column 34, lines 4-12, and 53-57), and a method for producing the encoded polypeptide (column 33, lines 53-57), thus, the reference also anticipates claims 68-71 of the instant application.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 C.F.R. 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Claims 64-67 remain rejected under 35 U.S.C. 102(e) as anticipated by, or, in the alternative, under 35 U.S.C. 103(a) as obvious over Ebner et al., US 2003/0003545, for the reasons set forth in the last Office Action, paper No. 14, at page 4.

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Applicants argument, filed on 10 March 2003 (paper No. 15) has been fully considered, but is not deemed persuasive for reasons above as the traversal is based on the same ground as that above.

Conclusion:

No claim is allowed.

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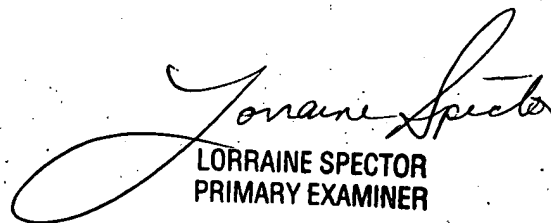
Advisory Information:

Any inquiry concerning this communication should be directed to Dong Jiang whose telephone number is 703-305-1345. The examiner can normally be reached on Monday - Friday from 9:00 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler, can be reached on (703) 308-6564. The fax phone number for the organization where this application or proceeding is assigned is 703-308-0294.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Dong Jiang, Ph.D.
Patent Examiner
AU1646
5/19/03


LORRAINE SPECTOR
PRIMARY EXAMINER